



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED  
DEC 8 2002  
TECH CENTER 1600/26000

#14  
JRP  
12/19/02

In re application of

Ryuji UENO, et al.

Appln. No. 09/816,655

Group Art Unit: 1614

Confirmation No.: 5746

Examiner: Zohreh A. FAY

Filed: March 26, 2001

For: APOPTOSIS INHIBITOR

### REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicants respectfully request withdrawal of the finality of the Office Action of November 5, 2002.

The Office Action includes a new ground of rejection, i.e., an anticipation rejection over EPA 0 435 443. However, this new rejection was not necessitated by an amendment in the last response, since the last response did not include an amendment. Further, while the Examiner notes that the new ground of rejection was necessitated by the submission of art by Applicants on April 24, 2002, Applicants note that the April 24, 2002 submission was based on an international search report mailed April 4, 2002, and that Applicants filed a Statement under 37 C.F.R. 1.97(e) setting forth that the disclosed information was first cited in a foreign search report issued not more than 3 months prior to the filing of the Information Disclosure Statement on April 24, 2002. In such a situation, it is improper for the Examiner to make a new rejection based on a reference disclosed in the disclosure statement final. See MPEP §706.07(a), which indicates that

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION  
APPLN. NO. 09/816,655

second or subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In view of the above, withdrawal of the finality of the present Office Action is respectfully requested.

SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3213  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860  
Date: December 13, 2002

Respectfully submitted,

Louis Gubinsky / Bruce E. Krame  
Louis Gubinsky / Reg. No. 33,725  
Registration No. 24,835